

REMARKS

Claims 1-22 are currently pending. The Examiner asserts that the current application represents four distinct and unrelated inventions:

- I. Claims 1-22 are drawn to a protective pad, classified in class 2, subclass, [sic] 455.
- II. Claims 24-25 are drawn to a helmet, classified in class 2, subclass 410.¹
- III. Claims 26-28 are drawn to a shoulder pad, classified in class 2, subclass 459.
- IV. Claims 29-33 are drawn to a method of making a pad, classified in class 2, subclass 267.

Restriction Requirement (10/3/05), P. 2. The Examiner further asserts that the inventions I, II, III and IV are structurally different from one another since Invention I pertains to a protective pad, Invention II pertains to a helmet, Invention III pertains to a shoulder pad and Invention IV pertains to a method of making a pad. Restriction Requirement (10/3/05), P. 2.

The following remarks are considered by applicant to traverse the Examiner's outstanding restriction requirement. However, should the examiner maintain his assertion that an election must be made, Applicants hereby elect Invention I corresponding to claims 1-22, which are directed to a protective pad.

¹ Applicants note that Examiner has failed to include Claim 23 as being related to any of Inventions I-IV. However, as Claim 24, linked to Invention II, is dependent from Claim 23, Applicants assume that it was the intent of the Examiner to include Claim 23 in Invention II and will proceed accordingly.

I. ONLY ONE INDEPENDENT INVENTION IS REPRESENTED BY THE CURRENT APPLICATION

The MPEP states that:

Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions **and** different effects are independent. An article of apparel and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

MPEP, 8th Ed., Rev. 3, § 8.06.06 (emphasis added)².

Thus four requirements must be met for two or more inventions to be independent:³

- (1) The inventions must not be disclosed as capable of use together;
- (2) The inventions must have different modes of operation;
- (3) The inventions must have different functions;
- (4) The inventions must have different effects.

The independent claims of the current application all relate to protective pads, types of protective pads (e.g. helmets, shoulder pads, etc.), and methods for fabricating protective pads, all of which contain “a pre-tensioned resilient padded membrane.” As such, applicants submit that claims 1-22 are generic claims to the invention: a protective pad containing “a pre-tensioned resilient padded membrane.” Invention II (claims 23-25) relates to a specific type of a protective pad containing “a pre-tensioned resilient padded membrane”: a helmet. Invention III (claims 26-28) relates to another specific type of a protective pad containing “a pre-tensioned resilient padded membrane”: a shoulder pad. As

² It should be noted that this is the corresponding section to MPEP, 8th Ed., Rev. 2, § 806.04 , which was cited by the Examiner in Office Action (10/3/05).

³ It is important to note that the language in this section of the MPEP has changed from Rev. 2 to Rev. 3 in that where before there was an “or”, indicating that the inventions would be independent if any of the listed requirements were met, there is now an “and”, indicating that all of the requirements must now be met for the inventions to be independent.

such, the generic claims 1-22 encompass the more specific claim groups of Invention II (claims 23-25) and Invention III (claims 26-28). Furthermore, Applicants respectfully assert that claims 1-22, drawn to a protective pad, and claims 29-33 (Invention IV), drawn to a method of making a protective pad, fall within the same subclass.

As can be seen by comparing claims 1-22 with the other three groups, the independent claims do not have different modes of operation: all the claims relate to protective pads that contain “a pre-tensioned resilient padded membrane.” The claims of the current application are not like the examples in the MPEP (i.e., article of apparel and a locomotive bearing, a process of painting a house and a process of boring a well). The current situation is more like a generic automobile and an SUV, both being automobiles, containing the same engine. As such, the claims of the current application only represent one independent invention.

That the claims are all related is evidenced by the Examiner’s classification of claims 1-22 as class 2, subclass 455. Subclass 455 is the broad subclass “Guard or Protector”. All the other subclasses listed by the Examiner are one level underneath the broad subclass “Guard or Protector”. Therefore, claims 23-33 are all capable of falling in the same subclass as claims 1-22: “Guard or Protector”.

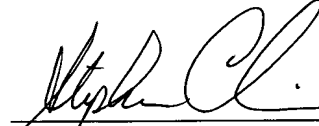
For all the foregoing reasons, Applicants respectfully assert that claims 1-33 are all generic to the same independent invention and that a restriction requirement is unnecessary.

II. ELECTION SHOULD EXAMINER INSIST ON RESTRICTION

Should the Examiner maintain his assertion that the current application represents four distinct inventions, Applicants hereby elect Invention I corresponding to claims 1-22, which are directed to a protective pad.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Stephen M. Chin', is written over a horizontal line.

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